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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,977	09/11/2000	Steven J. Sculler	M&R 3.0-033	5802

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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/658,977

Applicant(s)

SCULLER ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☒ Claim(s) 1-46 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

The drawings filed on 09/11/2000 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 1 - 46 are objected to because of the following informalities: The applicant through out these claims continually changes naming convention with respect to the buyer and seller. For instance, the naming convention for a buyer and seller changes in these claims from buyer/seller to include first entity, second entity, third entity to first member and second member, etc. In that regard and for examination purposes, the different naming conventions were not used; rather the buyer and seller naming convention was used as much as possible. The applicant will need to address providing clarity with regard to their naming convention relative to buyer and seller in

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these claims. In addition, the same objections apply to the word "relationship" used through out these claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 18, 21 - 34 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For example in Claim 1, the applicant has not recited the use any technology in the body of the claim following the word comprising and therefore these steps could be conducted manually.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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Claims 3, 21 – 27, 30 – 34, 39, 41, 42, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over “iPrint, Inc. Technology Selected to Power Leading Office Services Franchise”; Business Wire; New York; Feb. 8, 1999, Business Editors (hereafter referred to as “iPrint I”) and “iPrint.com to Offer Free Picture Mug to Intel WebOutfitter Service Members”; Business Wire; New York; Aug. 17, 1999; Business Editors/Technology Writers (hereafter referred to as “iPrint II”).

Regarding Claim 3, iPrint teaches a method wherein said product is a stamp (Page 2, Para 3).

Regarding Claim 21 and related Claim 41, iPrint I teaches a computer-implemented method of providing information about a product including typesetting comprising - (a) storing data representing a product available from a first member to a class of customers, said product including typesetting (Page 1, Para 1, 2, 3, 4 and 5 and Page 2, Para 1, 2 and 3); (b) storing data representing an agreement by a second member to provide said product said first member (Page 1, Para 4); (c) receiving a customer request from a customer of said class of customers for said product, said customer request including typesetting information describing said typesetting (Page 2, Para 5); (d) storing said customer request (Page 2, Para 2 and 3); (e) retrieving said agreement based on the identity of said product and said first member associated with said customer request (Page 2, Para 2 and 3); (f) generating a second request that said

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second member provide said product to said first member, said second request identifying said typesetting information (Page 2, Para 2 and 3); (g) transmitting said second request to said second member (Page 2, Para 1, 2 and 3). Moreover and

regarding Claim 22, iPrint I teaches a method of claim wherein said class of customers comprises a single entity (Page 2, Para 2).

regarding Claim 23, iPrint I teach a method further comprising storing data representing an agreement by a third member to provide said product to said second member; retrieving said agreement by said third member based on the identity of said product and the identity of said second member (Page 2, Para 2 and 3).

regarding Claim 24, iPrint II teaches a method wherein said typesetting information comprises an image (Page 4, Para 3 and 4) –as well as (25) the steps of receiving a plurality of requests from a plurality of customers of said class of customers, and wherein the image associated with one customer request is different from the image associated with another customer request (Page 4, Para 3 and 4).

regarding Claim 26, iPrint II teaches a method further comprising wherein said step of storing said customer requests from said customers comprises storing said different images in the same file format (Page 4, Para 4) and (27) the step of said second member retrieving said image (Page 4, Para 3 and 4).

regarding Claim 30, iPrint II teaches a method wherein said different file formats correspond with file formats used by said members (Page 4, Para 4).

regarding Claim 31, iPrint I teaches a method further comprising the step of manufacturing said product (Page 2, Para 5).

regarding Claim 32, iPrint I teaches a method wherein said product is a stamp and said typesetting relates to the impression on said stamp (Page 2, Para 5).

regarding Claim 33, iPrint I teaches a method wherein said requests identify said typesetting information by reference to information stored in a database (Page 2, Para 5 and 8).

regarding Claim 34, iPrint I teaches a method wherein said step of receiving said customer request comprises receiving said customer request over a global telecommunications network (Page 1, Para 1).

regarding Claim 39, iPrint I teaches a system for storing information about relationships between buyers and sellers, said system maintained by an administrator, said system comprising - (a) data representing an agreement by a middle entity to provide a product to a bottom entity in exchange for compensation and an agreement by a top entity to

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provide a related product to said middle entity in exchange for compensation, none of said entities being said administrator (Page 1, Para 1 -5), and (b) a processor for utilizing said data to process a request for said product from said bottom entity to said middle entity such that said request generates a request for said product from said middle entity to said top entity (Page 1, Para 1 and 2).

regarding Claim 42, iPrint II teaches a method wherein said personalization information comprises an image (Page 4, Para).

regarding Claim 45, iPrint I teaches wherein said product comprises a stamp having an impression representing said image (Page 2, Para 3).

regarding Claim 46, iPrint I teaches wherein said product comprises a printed item or sign containing said image (Page 2, Para 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over “iPrint, Inc. Technology Selected to Power Leading Office Services Franchise”; Business Wire; New York; Feb. 8, 1999, Business Editors (hereafter referred to as “iPrint I”) and “iPrint.com to Offer Free Picture Mug to Intel WebOutfitter Service Members”; Business Wire; New York; Aug. 17, 1999; Business Editors/Technology Writers (hereafter referred to as “iPrint II”) in view of Hess et al (US Patent 6,058,417).

iPrint I and II disclose and teach a computer-implemented method of providing information about a product including typesetting comprising - (a) storing data representing a product available from a first member to a class of customers, said product including typesetting; (b) storing data representing an agreement by a second member to provide said product said first member; (c) receiving a customer request from a customer of said class of customers for said product, said customer request including typesetting information describing said typesetting; (d) storing said customer request; (e) retrieving said agreement based on the identity of said product and said first member associated with said customer request; (f) generating a second request that said second member provide said product to said first member, said second request identifying said typesetting information; and (g) transmitting said second request to said second member.

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iPrint I and II on the other hand, do not specifically disclose and teach a method further comprising the step of converting said image from said file format to a different file format before said step of said second member retrieving said image and a method wherein said step of storing said customer requests from said customers comprises storing said different images in different file formats.

However and regarding Claim 28, Hess teaches a method further comprising the step of converting said image from said file format to a different file format before said step of said second member retrieving said image (Figures 7 – 10).

Regarding Claim 29, Hess teaches a method wherein said step of storing said customer requests from said customers comprises storing said different images in different file formats (Col 3, lines 20 –25 and Figure 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of iPrint I and II with the method of Hess to have provided the capability including the step of converting said image from said file format to a different file format before said step of said second member retrieving said image and a step of storing said customer requests from said customers comprises storing said different images in different file formats – in order to eliminate the business complexity for the potential customers and suppliers through eliminating concerns regarding file structure and thus negating the need to buy extra equipment - as well as

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to reduce their process steps. Thereby making it easier, faster and less costly for customers and suppliers in doing business, which will increase satisfaction for both, and provide more available cash for other purchases by customers.

Claims 1, 2, 4 – 20, 35 - 38, 40, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (US Patent 6,260,024 B1) in view of Webber, Jr (US Patent 6,167,378).

Regarding Claim 1 and related portions of Claims 35, 36 and 43, Shkedy teaches a computer implemented method and system retrieving product distribution information comprising - (a) storing first relationship information and second relationship information, said relationship information identifying a buyer, a seller and a product to be provided from said seller to said buyer (Col 1, lines 8 – 12 and Figure 2), (b) said first relationship information identifying a first entity as said buyer, a second entity as said seller, and a first product as said product (Col 10, lines 1 – 28 and Figure 2) as well as retrieving said first relationship (Col 10, lines 36 – 44). Moreover:

regarding Claim 5, Shkedy teaches a method wherein said product is a service or a product and a service (Col 10, lines 29 – 30);

regarding Claim 6, Shkedy teaches a method wherein said steps of storing relationship information further comprises storing the compensation which seller agrees to accept

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for said product from said buyer (Col 10, lines 44 – 47) and (7) wherein said compensation is the price of the product (Col 5, lines 44- 46) - as well as (8) compensation is a commission (Col 8, line 8);

regarding claim 9, Shkedy teaches a method wherein said first entity is a class of entities (Col 3, lines 40 – 41);

regarding claim 10, Shkedy teaches a method wherein said class is the general public (Col 5, lines 32 – 35);

regarding Claim 11, Shkedy teaches a method wherein said step of retrieving said first relationship information comprises displaying to said first entity at least two products associated with those relationships identifying said first entity as said buyer, and determining said first relationship information based upon the product selected by an entity of said class (Col 13, lines 44 – 46);

regarding Claim 12, Shkedy teaches a method further comprising the step of storing a description of said product (Col 10, lines 26 – 32 and Figure 2) and (13) wherein said description comprises an image, a textual description, or an image and a textual description (Col 10, lines 26 – 30);

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regarding Claim 18, Shkedy teaches a method wherein said step of retrieving said second relationship information comprises searching for relationships wherein the buyer of the relationship identifies the seller of said first relationship and the product of the relationship identifies the product of said first relationship (Col 5, lines 10 – 17);

regarding Claim 19, Shkedy teaches a method further comprising the steps of storing additional relationships associated with said product; repeating said step of retrieving said second relationship by recursively assuming that some of the values of said first relationship are equal to the values of said second relationship (Col 7, lines 13 – 20) and (20) wherein said step of repeating terminates when there is no relationship identifying the seller of said second relationship as a buyer of the same product in another relationship (Col 7, lines 13 – 20);

regarding Claim 37, Shkedy teaches a system wherein said database is stored at a central location (Col 9, lines 20 – 23 and Figures 1 and 4) and (38) wherein the said database is stored at central location (Col 9, lines 20 – 23 and Figures 1 and 4);

regarding Claim 40, Shkedy teaches a system wherein said data further comprises another agreement by another entity to provide said product to said top entity (Col 6, lines 19 – 27);

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regarding Claim 44, Shkedy teaches a method further comprising the step of said members sending the agreement by sending information relating to such agreement to said database (Col 10, lines 1 – 62 and Figure 2).

On the other hand, Shkedy does not disclose and teach specifically regarding the second relationship information identifying said second entity as said buyer, a third entity as said seller, and said first product as said product, and retrieving said second relationship information based on the identity of said seller and the identity of said product contained in said first relationship information.

However and regarding claim 1 and related portions of claims 35, 36 and 43, Webber teaches a computer implemented method and system wherein (c) said second relationship information identifying said second entity as said buyer, a third entity as said seller, and said first product as said product (Col 5, lines 30 - 36), (e) retrieving said second relationship information based on the identity of said seller and the identity of said product contained in said first relationship information (Col 7, lines 41 – 44 and Figure 4) . In addition:

regarding Claim 2, Webber teaches a method of further comprising the step of storing third relationship information identifying said third entity as said buyer, a fourth entity as said seller, and said first product as said product (Col 7, lines 11 – 44 and Col 9, lines 11 - 18);

regarding Claim 4, Webber teaches a method of wherein said first product is a part of a second product and said first relationship identifies a second product containing said part (Col 8, lines 42 – 51 and Col 9, lines 51 – 56 and Figure 4);

regarding Claim 14, Webber teaches a method with the steps of - (a) said first entity requesting said first product from said second entity and storing said request (Figure 4), (b) storing a request for said first product by said second entity to said third entity based on the second relationship information retrieved during said step of retrieving said second relationship information (Col 13, lines 50 – 64 and Figure 4);

regarding Claim 15, Webber teaches a method further comprising - notifying said third entity of said request (Col 15, lines 63 – 67 and Col 16, lines 1 - 4) and (16) wherein said requests includes the quantity of said product (Col 15, line 65) - as well as (17) wherein said requests include the shipping destination or destinations of said product (Col 1, lines 4 – 5 and Figure 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Shkedy with the method and system of Webber to have provided the capability wherein the second relationship information identifying said second entity as said buyer, a third entity as said seller, and said first product and retrieving said second relationship information based on the identity of said

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seller and the identity of said product contained in said first relationship information – in order to ensure ordering capability with partners/suppliers to more closely integrate and reduce the supply chain order timeframe and thus ensure rapid response to customer orders. With this rapid response to customer orders, through this closer integration of partners, will delight the customers when they receive the product rapidly and thereby increase the probability of another order.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Conklin et al (US Patent 6,338,050 B1) which addresses on-line buying and selling products, Barnes (US Patent 5,970,475) addresses e-procurement and Clark (US Patent 6,351,738 B1) as well as Chipman et al (US Patent 6,292,894 B1) which address catalog buying and selling on-line as well as establishing through a third entity a buying and selling for vertical communities such as for the printing/personalized products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703.305.7658
for regular communications and 703.308.3687 for After Final communications.



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RER

February 7, 2003